



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Roy A. Black *et al.*
Title: CRYSTALLINE TNF- α -CONVERTING ENZYME AND
USES THEREOF
Appl. No.: 10/057,321
Filing Date: 09/24/2001
Examiner: Kathleen M. Kerr
Art Unit: 1652

PETITION UNDER 37 C.F.R. § 1.181 TO INVOKE THE SUPERVISORY
AUTHORITY OF THE COMMISSIONER

Group Director of Group 1600
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This communication relates to an Office Action mailed on July 1, 2004, in the above-captioned case. As discussed below, the examiner has erroneously objected to an amendment to the specification which incorporates prior applications by reference.

The examiner asserts that prior applications can be incorporated by reference only via an amendment specifically referred to in a declaration executing the application. *See* Office Action, pg. 3, ¶ 3. The assertion is legally erroneous, however.

According to the MPEP §201.06(c) (page 200-25, May 2004), “[a]s a safeguard . . . an applicant may incorporate by reference the prior application by including, in the continuation or divisional application-as-filed, a statement that such specifically enumerated prior application or applications are “hereby incorporated herein by reference.” The MPEP further notes that the incorporation statement “must be included in the specification-as-filed, or transmittal letter-as-filed, or in an amendment specifically referred to in an oath or declaration executing the application.” *Id.*

In the instant case, applicants have incorporated by reference prior application Nos. 09/611,722 and 09/244,984 by including the incorporation statement in the respective transmittal letters-as-filed. *See* Transmittal letters filed July 6, 2000 and

September 24, 2001. Thus, the examiner committed a legal error by asserting that the applications were incorrectly incorporated by reference.

Having properly incorporated the prior applications by reference, applicants now seek to amend the specification to reflect the incorporation. As an alternative to the amendment submitted on September 24, 2001, applicants will submit the following amendment to the specification in their response to the pending office action:

At page 1, delete the paragraph beginning on line 5 and replace it with the following text:

--This application is a continuation of U.S. Serial No. 09/611,722 filed July 6, 2000, which is a divisional of U.S. Serial No. 09/244,984 filed on February 4, 1999, both of which are hereby incorporated herein by reference. U.S. Serial No. 09/244,984 claims the priority benefit of U.S. Provisional Application No. 60/117,476 filed on January 27, 1999, U.S. Provisional Application No. 60/135,499 filed on March 30, 1998, and U.S. Provisional Application No. 60/073,709 filed on February 4, 1998. --

Accordingly, applicants request the Group Director to invoke his supervisory authority, to overrule the rejection and to accept the proposed amendment.

Respectfully submitted,



R. Brian McCaslin
Reg. No. 48,571

31 August 2004
Date

FOLEY & LARDNER LLP
Customer Number: 22428
3000 K Street, N.W., Suite 500
Washington, D. C. 20007-5109
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No.: 16761/154

Applicant: Roy A. BLACK *et al.*
Prior Appl. No.: 09/244,984
Prior Appl. Filing Date: February 4, 1999
Examiner: N. Ogihara
Art Unit: 1631
Title: CRYSTALLINE TNF- α -CONVERTING ENZYME AND USES THEREOF

CONTINUING PATENT APPLICATION
TRANSMITTAL LETTER

Assistant Commissioner for Patents
Box PATENT APPLICATION
Washington, D.C. 20231

Sir:

Transmitted herewith for filing under 37 C.F.R. § 1.53(b) is a:

☒ [X] Division

of the above-identified copending prior application in which no patenting, abandonment, or termination of proceedings has occurred. Priority to the above-identified prior application is hereby claimed under 35 U.S.C. § 120 for this continuing application. The entire disclosure of the above-identified prior application is considered as being part of the disclosure of the accompanying continuing application and is hereby incorporated by reference therein.

Enclosed are:

- ☒ [X] Specification (including Abstract) - 91 Pages
- ☒ [X] Claim(s) - 12
- ☒ [X] Preliminary Amendment
- ☒ [X] Informal drawings - Figures 1-6 (7 sheets)
- ☒ [X] Copy of Declaration and Power of Attorney (9 pages)
- ☒ [X] Information Disclosure Statement.
- ☒ [X] Form PTO-1449 (39 References)
- ☒ [X] Notice to Comply with Sequence Disclosures

The filing fee is calculated below:

	Claims as Filed	Included in Basic Fee	Extra Claims	Rate	Fee Totals
Basic Fee				\$690.00	\$690.00
Total Claims:	12	- 20	= 0	x \$18.00	= \$0.00
Independents:	4	- 3	= 1	x \$78.00	= \$78.00
If any Multiple Dependent Claim(s) present:			+	\$260.00	= \$0.00
				SUBTOTAL:	= \$690.00
[]				Small Entity Fees Apply (subtract ½ of above):	= \$0.00
				TOTAL FILING FEE:	= \$768.00

- [X] A check in the amount of \$768.00 to cover the filing fee is enclosed.
- [X] The Assistant Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Assistant Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

Please direct all correspondence to the undersigned attorney or agent at the address indicated below.

Respectfully submitted,

By 

John P. Isacson
Attorney for Applicant
Registration No. 33,715

Date: July 6, 2000

FOLEY & LARDNER
Washington Harbour
3000 K Street, N.W., Suite 500
Washington, D.C. 20007-5109
Telephone: (202) 672-5402
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Roy A. BLACK *et al.*
 Prior Application No.: 09/611,722
 Prior Filing Date: July 6, 2000
 Examiner: S. Zhou
 Art Unit: 1631
 Title: CRYSTALLINE TNF- α -CONVERTING ENZYME AND
 USES THEREOF



CONTINUING PATENT APPLICATION
TRANSMITTAL LETTER

Commissioner for Patents
 Washington, D.C. 20231
BOX PATENT APPLICATIONS

Sir:

Transmitted herewith for filing under 37 C.F.R. § 1.53(b) is a:

☒ Continuation ☐ Division ☐ Continuation-In-Part (CIP)

application of U.S. Serial No. 09/611,722 filed July 6, 2000, which is a divisional of U.S. Serial No. 09/244,984 filed on February 4, 1999, which claims the priority benefit of U.S. Provisional Application No. 60/117,476 filed on January 27, 1999, U.S. Provisional Application No. 60/135,499 filed on March 30, 1998, and U.S. Provisional Application No. 60/073,709 filed on February 4, 1998. The above-identified copending prior application is neither patented or abandoned. Priority to the above-identified prior application is hereby claimed under 35 U.S.C. § 120 for this continuation application. The entire disclosure of the above-identified prior application is considered as being part of the disclosure of the accompanying continuation application and is hereby incorporated by reference therein.

Enclosed are:

- ☒ Petition for One Month Extension of Time (1 page).
- ☒ Notice of Recordation of Assignment Document from Parent Application Serial No. 09/244,984 (2 pages); and Notice of Recordation of Assignment Document from Parent U.S. Patent No. 5,830,742 (4 pages);
- ☒ Preliminary Amendment (6 pages), including marked-up version (79 pages) and clean version section replacements (79 pages).
- ☒ Associate Power of Attorney for Brian McCaslin (1 page)

☒ Copy of Specification, Claims, Abstract (91 pages), and Drawings (7 sheets).

☒ Executed Declaration and Power of Attorney from Parent (9 pages).

☐ Applicant hereby asserts entitlement to Small Entity status under 37 C.F.R. § 1.27(c).

☐ Submission of Sequence Listing Under 37 CFR § 1.821(e)

☐ Information Disclosure Statement with copies of Form 1449 from parent application

The filing fee is calculated below:

	Claims as Filed	Included in Basic Fee	Extra Claims	Rate	Fee Totals
Basic Fee				\$710.00	\$710.00
Total Claims:	20	- 20	= 0	x \$18.00	= \$0.00
Independents:	1	- 3	= 0	x \$80.00	= \$0.00
If any Multiple Dependent Claim(s) present:			+	\$270.00	= \$0.00
				SUBTOTAL:	= \$710.00
<input type="checkbox"/>				Small Entity Fees Apply (subtract ½ of above):	= \$710.00
				TOTAL FILING FEE:	= \$710.00

☒ The required filing fees are enclosed.

☒ The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

Please direct all correspondence to the undersigned attorney or agent at the address indicated below.

Respectfully submitted,

24 September 2001
Date

Stephen A. Bent
Stephen A. Bent
Registration No. 29,768

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FOLEY & LARDNER LLP

my
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Atty. Dkt. No. 016761-0170

Commissioner for Patents:

Please acknowledge receipt of the above-identified documents by applying the U.S. Patent and Trademark Office receipt stamp hereto.

Applicant: Roy A. Black *et al.*

Title: CRYSTALLINE TNF- α -CONVERTING ENZYME AND USES THEREOF

Appl. No.: 10/057,321

Filing Date: 09/24/2001

Examiner: Kathleen M. Kerr

Art Unit: 1652

INCLUDES:

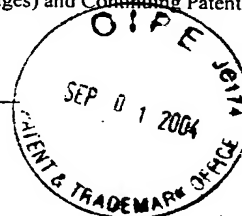
1. Transmittal Cover Letter (2 pages).
2. Petition Under 37 C.F.R. § 1.181 To Invoke the Supervisory Authority of the Commissioner (2 pages).
3. Copy of Continuing Patent Application Transmittal Letter filed July 6, 2000 (2 pages) and Continuing Patent Application Transmittal Letter filed September 24, 2001 (2 pages).

Date Due: September 1, 2004

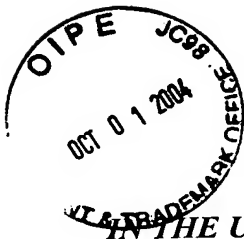
Date Filed: September 1, 2004

Return To: SABE/BGM/mjl

Insp. By: CSK



LLL



Atty. Dkt. No. 016761-0170

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Roy A. Black *et al.*
Title: CRYSTALLINE TNF- α -CONVERTING ENZYME AND
USES THEREOF
Appl. No.: 10/057,321
Filing Date: 09/24/2001
Examiner: Kathleen M. Kerr
Art Unit: 1652

TRANSMITTAL COVER LETTER

Group Director of Group 1600
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted Herewith is a Petition in the above-identified application.

- [X] Petition Under 37 C.F.R. § 1.181 To Invoke The Supervisory Authority of The Commissioner (2 pages).
- [X] Copies of Continuing Patent Application Transmittal Letter filed July 6, 2000 (2 pages) and Continuing Patent Application Transmittal Letter filed September 24, 2001 (2 pages).
- [X] The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Please direct all correspondence to the undersigned attorney or agent at the address indicated below.

Respectfully submitted,

Date 31 August 2004

By 

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R. Brian McCaslin
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